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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,895	02/04/2005	Fortunato Fedegari	47966.9.1	1054
22859 7590 04/11/2007 INTELLECTUAL PROPERTY GROUP FREDRIKSON & BYRON, P.A. 200 SOUTH SIXTH STREET SUITE 4000 MINNEAPOLIS, MN 55402			EXAMINER FRISTOE JR, JOHN K	
			ART UNIT	PAPER NUMBER
			3753	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/11/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/523,895

Applicant(s)

FEDEGARI, FORTUNATO

Examiner

John K. Fristoe Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-6,9-14 and 16-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-6,9-14 and 16-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 February 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/13/2007 has been entered.

### ***Response to Arguments***

2. Applicant's arguments filed 3/13/2007 have been fully considered but they are not persuasive. Applicant first argues that amendment to claim 4 overcomes the indefiniteness rejection, the examiner agrees. Therefore the 112 rejection of claim 4 has been withdrawn. Applicant then argues that the disc of Jarrett is not in a tangential orientation with the chamber. The examiner considers this "tangential" orientation to be new matter added to the application. However it is unclear how the disc is in a tangential orientation with respect to the chamber since it appears that the disc is in the chamber. With respect to Applicant's remaining arguments, the arguments are moot in view of the new grounds of rejection.

### ***Claim Objections***

3. Claim 11 is objected to because of the following informalities: in line 20, "value" should be replaced with "valve". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

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pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 2-6, 11-13, 16, 22, and 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The disc being in a "tangential" orientation appears to not be supported by Applicant's specification or drawings.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 2-5, 12, 16, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 3,134,570 (Jarrett). Jarrett discloses a shut-off valve comprising a body (11a), a chamber (15a), a first duct (adjacent the reference number 15a in figure 3) or inlet duct, a second duct (adjacent the lead line for element 11a in figure 3) or outlet duct, a closure member (22a, 33a, 16a), a central core (33a), a head (22a) having a larger diameter (figure 3) that the first duct (adjacent the reference number 15a in figure 3), a convex sealing face (adjacent the lead lines for element 22a in figure 3), a flexible circular disc (16a) integrally formed with the head (22a) fixed to the outer surface (via element 35a) of the chamber (15a), an open position (right side of figure 3), a closed position (left side of figure 4), an inner opening (14a), wherein the disc includes a portion (35a), wherein the second duct (adjacent the lead line for element 11a in figure 3) curves

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downward (upper surface of the duct curves down in figure 3), wherein the head (22a) diverges from 20 to 45 degrees (figure 3), wherein the disc has a surface area that is 10-20% greater than a cross-section of the first duct (figure 3), and wherein the closure member (22a, 33a, 16a) is a one-piece member (figure 3).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 3,134,570 (Jarrett) in view of U.S. Pat. No. 4,826,132 (Moldenhauer). Jarrett discloses a shut-off valve comprising a body (11a), a chamber (15a), a first duct (adjacent the reference number 15a in figure 3) or inlet duct, a second duct (adjacent the lead line for element 11a in figure 3) or outlet duct, a closure member (22a, 33a, 16a), a central core (33a), a head (22a) having a larger diameter (figure 3) than the first duct (adjacent the reference number 15a in figure 3), a convex sealing face (adjacent the lead lines for element 22a in figure 3), a flexible circular disc (16a) integrally formed with the head (22a) fixed to the outer surface (via element 35a) of the chamber (15a), an open position (right side of figure 3), a closed position (left side of figure 4), an inner opening (14a), wherein the disc includes a portion (35a), wherein the second duct (adjacent the lead line for element 11a in figure 3) curves downward (upper surface of the duct curves down in figure 3), wherein the head (22a) diverges from 20 to 45 degrees (figure 3), wherein the disc has a surface area that is 10-20% greater than a cross-section of the first duct

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(figure 3), and wherein the closure member (22a, 33a, 16a) is a one-piece member (figure 3) but lacks the closure member being made from a flexible plastic. Moldenhauer teaches a shut-off valve comprising a closure member (10, 12), a disc (12), and wherein the closure member is made of a flexible plastic (col. 3, lines 38-39). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the shut-off valve of Jarrett by making the closure member of a flexible plastic as taught by Moldenhauer in order to create an effective seal in the closed position of the valve.

2. Claims 17-21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 3,134,570 (Jarrett) in view of U.S. Pat. No. 5,277,401 (Butler et al.). Jarrett discloses a shut-off valve comprising a body (11a), a chamber (15a), a first duct (adjacent the reference number 15a in figure 3) or inlet duct, a second duct (adjacent the lead line for element 11a in figure 3) or outlet duct, a closure member (22a, 33a, 16a), a central core (33a), a head (22a) having a larger diameter (figure 3) than the first duct (adjacent the reference number 15a in figure 3), a convex sealing face (adjacent the lead lines for element 22a in figure 3), a flexible circular disc (16a) integrally formed with the head (22a) fixed to the outer surface (via element 35a) of the chamber (15a), an open position (right side of figure 3), a closed position (left side of figure 4), an inner opening (14a), wherein the disc includes a portion (35a), wherein the second duct (adjacent the lead line for element 11a in figure 3) curves downward (upper surface of the duct curves down in figure 3), wherein the head (22a) diverges from 20 to 45 degrees (figure 3), wherein the disc has a surface area that is 10-20% greater than a cross-section of the first duct (figure 3), and wherein the closure member (22a, 33a, 16a) is a one-piece member (figure 3) but lacks the shut-off valve attached to the bottom of the tank. Butler et al. teach a shut-off valve

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comprising a valve body (23), a diaphragm (13), a tank (10), and wherein the shutoff valve is attached to the bottom of a tank (figure 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the shut-off valve of Jarrett by installing the valve on the bottom of a tank as taught by Butler et al. in order to control the flow of fluid through a tank opening.

3. Claims 9, 10, 14, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 3,134,570 (Jarrett) in view of U.S. Pat. No. 4,828,219 (Ohmi et al.). Jarrett discloses a shut-off valve comprising a body (11a), a chamber (15a), a first duct (adjacent the reference number 15a in figure 3) or inlet duct, a second duct (adjacent the lead line for element 11a in figure 3) or outlet duct, a closure member (22a, 33a, 16a), a central core (33a), a head (22a) having a larger diameter (figure 3) than the first duct (adjacent the reference number 15a in figure 3), a convex sealing face (adjacent the lead lines for element 22a in figure 3), a flexible circular disc (16a) integrally formed with the head (22a) fixed to the outer surface (via element 35a) of the chamber (15a), an open position (right side of figure 3), a closed position (left side of figure 4), an inner opening (14a), wherein the disc includes a portion (35a), wherein the second duct (adjacent the lead line for element 11a in figure 3) curves downward (upper surface of the duct curves down in figure 3), wherein the head (22a) diverges from 20 to 45 degrees (figure 3), wherein the disc has a surface area that is 10-20% greater than a cross-section of the first duct (figure 3), a hand wheel (28a) and wherein the closure member (22a, 33a, 16a) is a one-piece member (figure 3) but lacks a threaded sleeve, collar and a resilient means between the sleeve and collar. Ohmi et al. teach a shut-off valve comprising a hand wheel (62), a threaded sleeve (64), Bellville springs (70), a collar (68), a head (36), a body (10), and a diaphragm (30). It

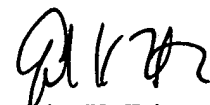
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would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the shut-off valve of Jarrett by controlling the valve with a threaded sleeve and collar with Bellville springs between them as taught by Ohmi et al. in order to more accurately control the flow of fluid through the valve as well as to assist in opening the valve.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John K. Fristoe Jr. whose telephone number is (571) 272-4926. The examiner can normally be reached on Monday-Friday, 7:00 a.m.-4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric S. Keasel can be reached on (571) 272-4929. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John K. Fristoe Jr.  
Examiner  
Art Unit 3753

JKF